

Appl. No. : ~~10/668,174~~ 101665,174
Filed : September 17, 2003

REMARKS

By way of summary, Claims 39–56 are pending in the present application. In the present Office Action dated February 9, 2005, the Examiner rejected Claims 1–38 under 35 U.S.C. § 102(b) and § 103(a). However, Claims 1–38 were canceled in a Preliminary Amendment filed on September 17, 2003. Thus, they are not in the present case. New Claims 39–56 were added by the same preliminary amendment, though.

Subsequent to the Preliminary Amendment, and in an Office Action dated August 23, 2004, the presently-pending Claims 39–56 were rejected on obviousness-type double patenting grounds. In response to the rejection, the Applicants filed a terminal disclaimer on November 15, 2004. The present Office Action indicated acceptance of the terminal disclaimer. Thus, it appears that Claims 39–56 reflect patentable subject matter. In the event that the Examiner intends or intended to cite prior art against those Claims, Applicants present the following remarks.

Schwartz Has No Applicability To The Pending Claims

Applicants respectfully submit that U.S. Patent No. 5,613,652 to Schwartz, which the Examiner cited against Claims 1–38, does not anticipate Claims 39–56 because Schwartz fails to teach every element of the rejected claims.

Schwartz discloses a male erection facilitation sheath that causes selective constriction around and/or along portions of the penis by pressure applied to such portions so as to impede venous blood flow therefrom. See Abstract of Schwartz Patent. The sheath is formed of latex, see cols. 4:35–36, 6:47–51, and is also configured to be used as a condom, see col. 1:9–10. The sheath has a liquid retaining chamber 32 that is adapted to hold various types of medication, and the liquid retaining chamber 32 is partitioned from the condom 2 except for communication therebetween by a one-way valve 36, see col. 6:36–37, 44–46. The liquid retaining chamber 32 is configured such that upon application of external pressure thereon, the liquid pressure within the chamber 32 increases such that the orifice 38 is urged open and the medication flows into the condom 2 and onto the penis, see col. 6:51–54. The liquid retaining chamber 32 may be arranged in longitudinally extending channels 34 with a plurality of one-way valves 36 located therein, see col. 6:41–43, 54–58.

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The Examiner suggests that the valves of Schwartz are suture holes. They are not, and there is nothing in Schwartz to suggest they are. As such, Schwartz has no applicability to the pending claims.

Request For Telephone Interview

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Applicants' undersigned attorney of record hereby formally requests a telephone interview with the Examiner.

In addition, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 5/9/05

By: [Signature]

Vito A. Canuso III
Registration No. 35,471
Attorney of Record
Customer No. 20,995
(949) 760-0404

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